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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,040	02/05/2001	Gary A. Sigel	A148 1330	8701

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/777,040

Applicant(s)

SIGEL ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22,38-45 and 55-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22,38-45 and 55-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed March 24, 2003.

Claims 1-3, 6, 9-12, 38 and 42 were amended and new claims 55-60 were added rendering claims 1-22, 38-45 and 55-60 pending.

Claim Rejections – 35 USC § 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-22, 38-40, 43-45 and 55-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidle et al. (U.S. 4,491,616) in view of Sherman et al (U.S. 5,985,416).

Schmidle discloses a decorative surface covering comprising a base layer (film) and a wear layer directly overlying and adjacent to the base layer comprising a radiation curable composition with regions of low and high gloss levels wherein the regions comprise a photoinitiator (photoinitiator and cure altering agent) (column 4, lines 64-68). Schmidle discloses that the wear layer comprises more than one initiator (first and

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second thermal initiators) (column 6, lines 3-7) and fillers such as clay and limestone (flatting agents) (column 5, lines 1-8). Schmidle discloses that a UV-curable composition of methacrylated polyester (UV-curable component) in the wear layer (column 11 to column 12). Schmidle further shows that the photoinitiator forms a discontinuous pattern in regions wherein the pattern is between the substrate and the wear layer and is in contact with the UV-curable composition (Abstract). Schmidle discloses that the wear and pattern layer comprising the UV-curable composition also comprises various heat stabilizers (thermal curing agent and gloss controlling agent) (column 4, line 64 to column 6, line 16). Schmidle discloses that the pattern includes a pigment (column 3, lines 63-67). Schmidle discloses a pigmented ink printing layer applied to the top of the base layer (claim 4) and is in register with the base layer (column 2, lines 1-10).

Claims 9 and 16-22 are rejected because they are product-by process claims. Additionally, the phrases 'wherein the different gloss levels are achieved by curing...using a first polymerization condition...in the region' (in claim 9), 'the second polymerization condition takes place after the first polymerization condition' (in claim 16), 'the first polymerization condition includes exposure to UV irradiation and/or heat' (in claim 17), 'the second polymerization condition includes exposure to EB or UV irradiation' (in claim 18), 'composition is polymerized in register with the photoinitiator in the selected regions by UV irradiation' (in claim 19), 'the UV-curable composition is subsequently further polymerized by electron beam irradiation (in claim 20), 'the UV-curable composition is polymerized by UV radiation' (in claim 21), and 'the UV-curable composition is subsequently further polymerized...by longer exposure times' (in claim

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22) introduce process limitations to the product claims. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113*. Further, process limitations are given no patentable weight in product claims. Schmidle does not disclose a thermoset top coat.

Sherman teaches a decorative surface covering comprising a substrate and thermoset coating covering the substrate which are heat cured on the sheet (column 2, lines 21-40). Schmidle and Sherman are analogous art because they are both from the field of surface coverings. It would have been obvious to one of ordinary skill in the art to include thermoset resins in the top coat of Schmidle because Sherman teaches it is important for the overlying coating to comprise thermoset resins so the coating will not soften when heated and can resist discoloration and degradation (column 3, lines 39-54).

Claim Rejections – 35 USC § 103(a)

4. Claims 21, 41-42 and 59-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidle et al. (U.S. 4,491,616) in view of Sherman et al (U.S. 5,985,416) further in view of Sigel et al. (U.S. 6,333,076).

Schmidle and Sherman are relied upon as above for claims 1-22, 38-40, 43-45 and 55-58. Though Schmidle teaches that the base layer comprises resinous polymer

compositions, Schmidle does not specifically teach that the base layer is transparent or translucent as in instant claim 41. However, Schmidle teaches that several types of backing sheets are equally suitable and are utilizable in special situations, such as transparent backing sheets (column 4, lines 17-43).

Schmidle does not teach that the UV-curable composition includes a photoinitiator as in instant claim 21. Schmidle does not teach that the wear layer is transparent or translucent. Sigel shows a gloss surface coated wear layer comprising a transparent wear layer (column 1, lines 24-27) and photoinitiators in a UV-curable resin layer (column 4, lines 8-31). Thus, it would have been obvious to one of ordinary skill in the art to employ a photoinitiator in a UV-curable composition in a transparent wear layer since it is known, as shown by Sigel, that a photoinitiator is effectively used with UV-curable compositions to aid in the formation of radicals upon UV radiation and that it is obvious to use a transparent wear layer for aesthetic purposes in making decorative floor coverings.

Response to Arguments

5. Remarks to the rejection(s) made under 35 USC 112, second paragraph are withdrawn due to amendment by Applicant.

Remarks to the rejection made under 35 USC 102(b) as being anticipated by Schmidle et al. (U.S. 4,491,616) is moot based on grounds of new rejection.

Additionally, remarks to the rejection made under 35 USC 103(a) as being unpatentable

over Schmidle et al. (U.S. 4,491,616) in view of Sigel et al. (U.S. 6,333,076) is moot based on grounds of new rejection.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the

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examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for

After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)

308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

